
IN THE

United States Circuit Court of Appeals,

NINTH CIRCUIT.

October Term, 1891.

No. 16.

STANDARD OIL COMPANY (A CORPORATION),

Appellant,

VS.

THE SOUTHERN PACIFIC COMPANY (A CORPORATION) AND WHITTIER, FULLER & CO. (A FIRM),

Appellees.

BRIEF OF WHITTIER, FULLER & CO.

One of the Appellees.

Filed by

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FILED

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STANDARD OIL COMPANY (a corporation),	} <i>Appellant,</i>
<i>vs.</i>	
SOUTHERN PACIFIC COM- PANY (a corporation), AND WHITTIER, FULLER & Co. (a firm),	} <i>Respondents.</i>

Respondent Whittier, Fuller & Co's Brief on
Appeal.

Mutilation of the Records.

Before entering upon a statement of the case, presented by this appeal, I desire to call the attention of the Court to certain *mutilations of the records* in this case, contained in the transcript served upon me, and filed with the Clerk of this Court. On page 143 of the transcript, is the specification of U. S. Letters Patent No. 163,515, issued to A. P. Odell May 16th, 1875. This patent was put

in evidence *by respondent* Whittier, Fuller & Co., and is marked Respondents' Exhibit 3, in this case. Upon examining this specification as printed in the transcript, I find certain parts *printed in italics*. The parts thus italicized, are exactly the parts that complainant relies upon to establish a difference between the car of complainant's patent, sued on, and the Odell car shown and described in Respondents' Exhibit 3. Knowing that the U. S. Patent Office *never printed any part of a specification of a patent in italics*, I immediately instituted an investigation, and I found that the parts italicized in the printed transcript have been underlined or underscored in the copy of the transcript furnished to the printer, and from which the printed transcript was made, but I found that the original transcript, in the possession of the Clerk of the Court, *has no underscoring or lines indicating italics*. It is therefore evident, that the underscoring was done by some unauthorized person, after the copy left the hands of the Clerk of the Court, and before it went into the hands of the printer.

Turning over the leaves of the transcript to Respondent's Exhibit 4, page 149, I find *the same kind of mutilation* carried out in the specification of that patent. Also in Respondent's Exhibit 5, page 151; also in Respondent's Exhibit 6, pages 155

and 157, near the bottom of the pages; also in Respondent's Exhibit 8, page 161.

*In every case, the matter underscored and italicized, is that particular part of the specification or description, to which complainant specially desires to draw the attention of the Court, just as such things are done in a brief or argument. This is unfair practice, and is calculated to unjustly influence the minds of the Court, because the Court is justified in presuming, that the printed transcript is a correct reproduction of everything it contains, and it possibly may not know that the printed copies of letters patents never contain italicized clauses or parts, in which case, such a falsification of the record might mislead the Court, and cause a litigant serious damage. I have no fear that the Court will be influenced by having the parts referred to italicized, because having its attention once directed to the *fact* it will not construe the patents by those parts *alone*, but will read the whole specification, and give such force and effect to the italicized parts, as they merit, in view of the whole description and specification, no more and no less. Nevertheless the practice should not be permitted. There seems to be no provision made in the rules of this Court, that the printed transcript should be certified to by the Clerk of the Court. The rules*

provide that the Clerk of the Court shall prepare a transcript of the record, and furnish a copy *to the attorney for appellant*, who shall have the same printed, and delivered to the Clerk of this Court. This provides no security against mutilation or falsification of the record, because it would be a very easy matter for a vicious attorney, under such circumstances, to make changes and alterations in the record, that might not be noticed, but would nevertheless greatly prejudice the case of the appellee. In the Supreme Court of the United States the Clerk of the Supreme Court oversees and supervises the printing of the transcript, and he alone is responsible for any error that may occur, but by the system under which transcripts are furnished the Court in this Circuit, there seems to be no one responsible for its correctness. The Court will pardon me for making these suggestions, but they seemed proper, and even necessary under the circumstances.

To call the attention of the Court to the falsifications of the record in this case, is sufficient to destroy any ill effect they might otherwise have in the consideration of the case.

Statement of the Case.

The complainant and appellant in this case is a vast corporation, organized and existing under the laws of the State of Iowa, but carrying on its business of dealing in oil, and oil products, throughout the length and breadth of the United States, and to a large extent monopolizing that business wherever its various ramifications extend.

The respondent, the Southern Pacific Company, is a railway corporation, managing and operating numerous lines of railways, between the Missouri River and the Pacific Ocean, chief of which are the Central Pacific and Southern Pacific Railways. Both of these roads terminate at San Francisco, California, at their western termini. In fact, these two railways are the only transcontinental railways that do connect directly with San Francisco. By virtue of its occupation the Southern Pacific Company is a common carrier for hire, and as such it is accustomed to receive and transport over its railroads, cars belonging to other corporations and individuals, and under the laws of the United States it is required to receive all cars delivered to it without discrimination, and transport the same (see verified answer of Southern Pacific Co., page 6, Transcript).

The respondent, Whittier, Fuller & Co., is a

firm engaged in the business of dealing in paints, oils, etc., at San Francisco, California. With the exception of the appellant, the Standard Oil Company, this firm is the largest dealer in oils on the Pacific Coast. It maintains branch houses in San Diego, Los Angeles, Oakland, Stockton and Sacramento, in California, and one at Portland, Oregon.

Up to the year 1885 all oil, that was brought from the Eastern States to this market, was either shipped in vessels around Cape Horn or in what is known as tank cars, by rail. This tank car was a simple sheet-iron cylinder, like a boiler, mounted on a car frame and trucks, so that the car could be coupled on behind any ordinary car, and transported by rail. Up to the year 1885 both the Standard Oil Company and Whittier, Fuller & Co. used these tank cars.

As nothing but oil could be carried in these tank cars, it is apparent, and is a fact, that they were only in use when moving in one direction, viz: from east to west, that is, they were loaded with oil at Cleveland, Ohio, or at some other Eastern point, and hauled westward, filled with oil. When they arrived at their western destination, the oil was removed from the tanks, and the cars were hauled back east, in an empty condition. The

railroad charge for hauling these empty cars back east, after they were emptied of oil at their western terminus, was ninety-five dollars for each car.

On the 1st day of July, 1885, the Standard Oil Co., appellant herein, acquired by assignment from the Continental Oil and Transportation Co., of California, the exclusive right, under U. S. letters patent No. 216,506, which was issued to M. Campbell Brown, of Cleveland, Ohio, on the 17th day of June, 1879, for an improved oil car (see Ex. F, p. 132, Transcript), and shortly thereafter it commenced to haul its oil, from east to west, in that class of cars.

This car is constructed with three compartments (see complainant's Exhibit A, page 127, Transcript), the two end compartments, immediately over the car trucks, being provided with oil tanks fitting in the compartments, while the intermediate or middle compartment, is a dry merchandise compartment, in which ordinary dry freight could be carried. It is practicable to use all of these compartments at one time, if it is desired, but in practice the oil tanks were used for carrying oil in one direction, west, while the freight or middle compartment was empty, but on the return trip, east, the dry freight compartment was used while the oil

tanks were carried empty. The railroad companies, it seems, had made an arrangement by which they transported the car, loaded with oil, from east to west, for the privilege of carrying freight in the dry compartment, on the return, or eastern trip of the car. By this arrangement the owner of the car could save the ninety-five dollars, return transportation, over and above the cost of transporting oil in the ordinary boiler tank cars.

The competition between the Standard Oil Co. and Whittier, Fuller & Co., on the Pacific Coast, had reduced the price of oil to such an extent, that this saving of ninety-five dollars per car load of oil, enabled the Standard Oil Co. to sell its oil cheaper than its competitor, in fact, it created a monopoly of the oil trade in its hands, that in time would have caused its competitor, Whittier, Fuller & Co., to either go out of the business, or into insolvency.

While in this dilemma, Whittier, Fuller & Co. consulted competent patent lawyers, and had a search made of the Patent Office records, by and through which means they were advised first, that the M. Campbell Brown patent, owned by the Standard Oil Co., was not a valid patent; second, that several patents had been granted by the United States Patent Office, to other parties, to prior in-

ventors, for a combination oil car, with separate oil and dry merchandise compartments, for carrying oil in one direction, and dry freight in the opposite direction, and that these patents were granted and issued long before the grant and issue of the M. Campbell Brown patent; and third, that Whittier, Fuller & Co. had as much right to get up and use a combination oil car, as Mr. M. Campbell Brown, or his assignee, and they were advised that as long as the car used by another person did not contain the *same specific combination and arrangement of parts*, as that claimed in the Brown patent, it would not be an infringement on that patent. In fact, Whittier, Fuller & Co. was advised to get up a different arrangement of car construction, and use it for transporting oil from the east.

Acting upon this advice, Whittier, Fuller & Co. designed a car, in which *only one oil tank was used*. This tank they placed in the middle of the car where it would not be subjected to the jolt and jar of the car trucks. The oil-tank was made *with a flat top*, instead of the sloping top, used in the Brown patent. The bottom of the tank *pitched or sloped towards the middle of the tank*, instead of towards one side, as in the Brown patent. *Its dome passed up through the top of the car, and the filling point was entirely above the roof of the car.* The

dry compartments were *at each end of the car*, over the trucks. The car had a *fixed stationary partition* between the oil-tank and dry compartment, instead of a removable partition, as in the Brown patent, and in various other particulars it varied from the Brown car.

After submitting the plan of this car to patent experts, and receiving the advice that it was no infringement on the Brown patent, Whittier, Fuller & Co. contracted with the Harrisburg Car Manufacturing Company, of Harrisburg, Pennsylvania, and had built, by that company, several cars after the plans thus devised, and these cars they put in use for transporting oil from the eastern States to the Pacific Coast.

After these cars had been running a short time, about the 1st of December, 1889, Whittier, Fuller & Co. failed to receive a shipment of some of said cars on time, which they had been advised, had been shipped to them. One car at least was overdue in San Francisco, and no notice of its arrival having been received, they inquired the reason of the delay at the office of the Southern Pacific Co. in San Francisco. The reply was, that it, the Southern Pacific Company, had been enjoined and restrained from hauling Whittier, Fuller & Co.'s cars, by an injunction issued out of the United States Circuit Court.

Whittier, Fuller & Co. then secured the services of an attorney, Jno. L. Boone, Esq., who immediately made an investigation amongst the records of the United States Circuit Court, for the Northern District of California, when the following interesting state of affairs was unearthed.

A Conspiracy.

It appeared from the records, that on the 4th day of November, 1889, the Standard Oil Co. as complainant, had filed its bill of complaint against the Southern Pacific Co. as respondent, charging it, the Southern Pacific Co., with infringing upon the letters patent issued to said M. Campbell Brown, and praying for an injunction and an accounting. (See Bill of Complaint, pages 1-2-3, Transcript.)

The subpoena ad respondendum, was issued by the Clerk of the Court on the same day, requiring the respondent, the Southern Pacific Company, to enter its appearance in said suit *on or before the first Monday of December, 1889*. (See *subpoena ad respondendum*, page 4, Transcript.)

The records in the office of the Clerk of the United States Court, Ninth Circuit, show, that on the —— day of —— an order was filed and served on the respondent, the Southern Pacific Company, to show cause why a *preliminary injunc-*

tion should not issue, restraining it from hauling any infringing car; that said order was heard, and a preliminary injunction was issued *without opposition*, restraining and enjoining the Southern Pacific Company from transporting any cars that infringed upon said patent, sued on, and that a bond was required by the Court in the sum of \$5,000, and that such bond was filed by the Standard Oil Company on the ——— day of ———.

None of these injunction proceedings appear in the transcript, but the record evidence exists in the office of the Clerk of the United States Circuit Court Northern District of California, showing that they were taken. Why were they not included in the transcript?

The answer of the respondent, the Southern Pacific Company, to the bill of complaint was filed December 2d, 1889, *and it admits that all the averments of the bill are true.* (See answer, page 5, Transcript.)

Before any answer was filed, and before any appearance was entered by the Southern Pacific Co., *in fact before any issue whatever was raised in said suit*, to wit: on November 26th, 1889, a special Examiner, A. L. Coombs, was appointed by the Court to take testimony in said cause, and said Coombs proceeded immediately, *on that day*, to wit:

November 26th, 1889, to take testimony in said cause, and did take the testimony of Charles A. Watson on said day. (See page 40, Transcript.) No one was present during the taking of said testimony on the part of the Southern Pacific Co., Mr. Pillsbury, of counsel for complainant, being the only attorney present. The record says: "Mr. Shay, of counsel for respondent, not being able to be present, requested that the examination proceed *without his presence.*" (Page 40, Transcript.)

On the 30th day of November, 1889, about one page of type-written testimony was taken in cross-examination of the witness Watson, by Mr. Shay, of counsel for respondent.

All this testimony was taken before any appearance of respondent, and before any answer was filed.

The date of the filing of this testimony does not appear in the transcript, but the official record in the office of the Clerk of the United States Circuit Court, Northern District of California, shows that it was filed on the day following that on which the answer was filed in the case.

The transcript, page 49, has this memorandum: " (Endorsed): Te timony opened by order of Court

“ and re-filed April 14, 1890. L. S. B. Sawyer, Clerk. By F. D. Monckton, Deputy Clerk.”

What for, why, or how it came to be opened by order of Court, and refiled April 14th, 1890, does not appear. Why does not the date of the original filing appear? Why state when it was refiled without stating when it was filed?

These are questions that must be answered by the official who prepared the transcript.

This testimony was taken, closed, sealed up and filed in the office of the Clerk of the Circuit Court on the 3d day of December, 1889, the day after the respondent, the Southern Pacific Company, filed its answer.

On the 4th day of December, 1889, Whittier, Fuller & Co., *for the first time*, learned that such a suit was in existence, *and at that time the case was ready to be submitted to the Court for its decision.*

On the 5th day of December, 1889, Whittier, Fuller & Co. filed a petition for interpleader (p. 7, Transcript). This petition was demurred to by the Standard Oil Co. (see Demurrer to Petition for Interpleader, p. 10, Transcript). The Southern Pacific Co. answered to the petition (see Answer to Petition for Interpleader, p. 12, Transcript).

This petition was heard by their Honors, Judges

Sawyer and Sabin, on the 9th day of December, 1889, and the prayer of the petition was granted, the Court ordering that complainant file an amended complaint, and make Whittier, Fuller & Co. parties respondent, and the bond of \$5,000 which had theretofore been given, on the issuance of the preliminary injunction, was, on the motion of this counsel raised to twenty thousand dollars (see order making Whittier, Fuller & Co. parties respondent, p. 13, Transcript).

On the 19th day of December, 1889, the complainant filed an amended bill (pp. 13, 14, 15, 16, Transcript).

A motion was made to strike this bill from the files, because it did not comply with the order of the Court. The motion was granted and the Court ordered that the complainant file a second amended bill.

This motion and order are not to be found in the transcript.

On the 3d day of January, 1890, the complainants filed a second amended bill of complaint (p. 17, Transcript).

To this bill of complaint, respondent Whittier, Fuller & Co. demurred (see demurrer of Whittier, Fuller & Co. to second amended bill, p. 20, Tran-

script), and the respondent, the Southern Pacific Company, filed its answer (see answer Southern Pacific Co. to second amended bill, p. 22, Transcript).

The demurrer of Whittier, Fuller & Co. was overruled on the 31st day of March, 1890, by his Honor Judge Sawyer, and the opinion of the Court overruling said demurrer can be found in Fed. Rep.

On the 7th day of April, 1890, Whittier, Fuller & Co. filed its answer (see answer of Whittier, Fuller & Co. to second amended bill, pages 26, 27, 28, Transcript).

The replication to answer of the respondent S. P. Co., was filed Feby 3d, 1890, and the replication to the answer of the respondent Whittier, Fuller & Co. was filed May 3d, 1890.

During these proceedings William P. Fuller, a member of the respondent firm of Whittier, Fuller & Co., died, and a bill of revivor was filed (page 30, Transcript), and an order of revivor made December 9th, 1890 (page 35, Transcript).

This is a brief and somewhat condensed history of the case, up to the time of taking testimony on the issue raised by the pleadings.

A motion to dissolve the preliminary injunction

was made by respondent Whittier, Fuller & Co. on the day of , 1890. This motion was partly heard by his Honor, the lamented late Judge Sabin, and the argument on this demurrer was, I believe, the last argument he ever listened to on the bench. Before the argument was completed the shadow of death fell across his threshold. Judge Sawyer was absent on a trip to the Eastern States, and as respondent Whittier, Fuller & Co. were suffering greatly, by reason of their cars being tied up (side-tracked) on the plains, and the case seemed an urgent one, his Honor, the lamented late Judge Hoffman, Judge of the District Court of the Northern District of California, being the only qualified Federal Judge in the District, was induced to hear the motion. After argument by the respective counsel, and a full investigation of the case, his Honor, Judge Hoffman, granted the order dissolving the injunction. The decision and opinion of Judge Hoffman dissolving the injunction, was printed, and a copy was filed with the papers in this case, in the office of the Clerk of the Circuit Court of the United States for the Northern District of California, *but it also seems to be missing.* The injunction proceedings, and the bonds given on the issuance of the injunction, the injunction itself, and the proceedings relating to the dissolution of the injunction, *are all left out of the*

transcript. Why they were left out cannot be answered by this counsel.

The Demurrer to the Second Amended Complaint.

Whittier, Fuller & Co.'s demurrer to the second amended complaint, is found on pages 20 and 21 of the transcript. It sets up, first, that the patent is void on its face, because the alleged invention described in the specification, and covered by the claim, did not involve invention; and second, that the alleged combination of elements covered by the claim of the patent, was a mere aggregation of old devices, each of which performed the same duty that it performed before it was aggregated, and none of which performed any other duty, different from what they performed before they were aggregated. That there was no joint or conjoint action between the different elements of the alleged combination. In fact that the patent was *void on its face*, because it fell under that class of proscribed patents, which the Supreme Court of the United States, and other Federal courts had denominated *aggregations*, and had over and over again declared were void.

On the argument of this demurrer, counsel for Whittier, Fuller & Co. offered in evidence, for the purpose of showing the state of the art, a certified copy of the file wrapper and contents, showing the action

of the Patent Office, and the action of the inventor, while the application was pending in the United States Patent Office, (this is another important document which has been omitted from the Transcript), and also certified copies of the several letters patent, respondent's Exhibits 2, 3, 4, 5, 6, 7 and 8, from pages 137 to 162, inclusive, in the Transcript. The introduction of these documents was strenuously objected to by counsel for complainant, but they were received by the Court. Afterwards counsel for Whittier, Fuller & Co., becoming convinced that the Court could not re-enforce its judicial knowledge in that way, in his brief on demurrer, withdrew them from the consideration of the Court, and requested the Court to pass upon the question presented, without reference to either the file wrapper and contents, or prior patents (see respondents', Whittier, Fuller & Co's, Brief on Demurrer to Amended Bill, on file in Clerk's office, page 4).

The Court, in overruling the demurrer, rendered the following opinion:

In Equity. On demurrer to bill. SAWYER, Judge.

This suit was brought by the Standard Oil Company against the Southern Pacific Company and Whittier, Fuller & Co., to restrain the infringement of Letters Patent No. 216,506, issued to M.

Campell Brown on June 17, 1889, for an improvement in oil-cars. In the specification it was said:

“ My invention relates to cars, and especially to that class of cars designed for transporting merchandise and oil or other liquids; and it consists in the parts and combination of parts hereinafter described and claimed, whereby oil or other liquids may be safely transported in the same car with miscellaneous merchandise. The object, as briefly above stated, of my device is to produce an improved form of car for the transportation of oils and liquids in bulk, which shall also be adapted for the transportation of ordinary merchandise on roads where a load of oil or liquid cannot be obtained on return trip, thus obviating the necessity of hauling empty tank-cars over long distances, as is now commonly done; and to this end the construction of the ordinary freight-car is modified as follows: The car-space is divided into two or more compartments, but for the purpose of the present specification, we will suppose it to be divided into three. The central compartment would embrace about two-thirds of the entire length of the car, and is designed and adapted for ordinary storage, and for this purpose may be constructed in any proper manner. The two end compartments occupy each about one-sixth of the entire length of the car, are located in the ends thereof over the trucks, and are designed and constructed to contain metallic tanks, which tanks are adapted for safely containing and transporting oil or other liquid.”

It further appeared from the specification that partitions were provided between the compartments,

extending from floor to roof, which were made removable and readily adjustable; that the floor of the central compartment was made level, while that of each end compartment was made slanting so as to afford reliable drainage; that the bottoms of the oil-tanks were made inclining, so as to fit on the bottoms of their compartments, and from the lowest point of each was a discharge-pipe; a filling-in opening was provided at the highest point on the top of the tank, which was also made on an incline, and this opening was made to register with an opening in the car-top. The claim of the patent was as follows:

“ A car subdivided into two or more compartments, each end compartment containing an oil-tank, said tank constructed with an inclined or self-draining bottom and resting upon a floor formed in counterpart thereto, said tank also having a tapering or inclined top, with a filling opening placed at or near its highest point and in line with a filling opening in the car-top, and there being a removable partition separating said tank from the next adjacent compartment, all combined substantially as set forth.”

Langhorne & Miller and *Pillsbury & Blanding*, for complainant.

Frank Shay, for defendant Southern Pacific Co.
John L. Boone, for defendants Whittier, Fuller & Co.

Before SAWYER, Circuit Judge.

SAWYER, J., (*orally.*) I have looked over the question in this case. The main proposition raised on demurrer is, whether this patent presents a case of a mere aggregation of devices instead of a combination, which would produce some common result. It lies very nearly on the border line under the various rulings of the Supreme Court. I am not prepared to say that there is not something more than an aggregation, at all events upon demurrer. It is true that the carrying of oil one way does not co-operate directly with the performance of carrying merchandise the other way. But do not the two co-operate directly in the performance of carrying merchandise both ways? Do not the two co-operate to produce a common result, that is a reduction of the cost of the transportation of oils by successive acts performed in different parts of the service? The result attained is a carriage at a much less cost. It saves the dead loss of hauling empty cars one way. In many combinations, each single operation by itself is not affected by the following or subsequent operations, but they all constitute one continuous operation and end in a common result. Is not that the nature of this case? One way oils are carried by these compartment cars, arranged expressly for the purpose of carrying oil, and then on the return voyage they carry other merchandise, in the intermediate compart-

ments combined with the others, instead of hauling back empty cars. Each carriage, considered by itself, is a separate performance, but what is the result? The result is a much cheaper transportation of the oil. Is not that a common result? And does not each carriage, though performed by itself, co-operate to produce that common result? As I said before, it lies very nearly on the border line of these cases which the Supreme Court have held to be a mere aggregation. In illustrating that very point the Supreme Court in one case said, speaking of the effect of a watch-stem operating, also, as a key to wind the watch, which performed the office of holding and carrying the watch, and also, the office of winding the watch, in distinguishing this from aggregation, the Court says:

“The office of the stem is to hold the watch or hang the chain to the watch; the office of the key is to wind it. When the stem is made the key, the joint duty of holding the chain and winding the watch is performed by the same instrument, a double effect is produced, or a double duty performed by the combined result. In these and numerous like cases the parts so co-operate in producing the final effect, sometimes simultaneously, sometimes successively. The result comes from the combined effect of the parts, not simply from the separate action of each, and is, therefore, patentable.”

Now, here with these cars—they carry oil one way, and carry merchandise the other way. They are successive operations, but they operate to

cheapen the transportation, and in this sense does it not come within the illustration of the watch-key? It saves the operation of hauling the empty car one way at an expense without any contributory compensation. I am not prepared to say at present on demurrer that the arrangement does not contribute to the common result of cheapening transportation and am not prepared to say that the arrangement is not patentable. I shall therefore overrule the demurrer, and reserve the question for further consideration if counsel desire, when the testimony all comes in, and I have the full case before me.

Mr. Boone. Does your honor take into consideration the fact that the result was not new?

The Court. Yes. I do not know but that it is new. If the result is the cheapening of transportation of oils, that result must be new. How can it cheapen if it does not do something which had not been done before? But, as I said before, I shall reserve it for further consideration. If the same oil could never have been carried before at so low a price the result was necessarily new. I do not know but what the result is new with reference to the transportation of oil.

Mr. Boone. I think the patent itself says no, that it is not new.

The Court. If it cheapens it must do something

not done before. A contrary view would involve a contradiction of terms. I shall at all events overrule the demurrer. Should counsel desire to further present the question, I will consider it on the further hearing. As I said before, it lies very near the line between an aggregation, and invention as illustrated by the decisions of the Supreme Court, and it is not very easy to determine on which side it falls.

It will therefore be seen that the sole ground on which the Court based its opinion was the *bare claim* of counsel for complainant, that oil could be carried in the patented car cheaper than it could be carried in the ordinary tank car.

I submit now that the Court erred in accepting the *mere statement* of counsel for complainants, that oil could be carried in the patented car, cheaper than it could be carried in a tank car. There was no evidence of such fact before the Court, and certainly the Court had no judicial knowledge on that point.

I say, therefore, that the Court erred in overruling the demurrer, but it is apparent from the opinion, that the Court was in grave doubt as to the correctness of its decision, *even admitting the matter of cheapness.*

The Southern Pacific Company as a Defendant.

It certainly seems strange that the Southern Pacific Company should persist in remaining a defendant in the case, when it became apparent that the defendant, Whittier, Fuller & Co. was the real party in interest, and after the admissions as to its interest in the controversy, contained in its filed answer (see Answer, page 6, Transcript, and Answer of S. P. Co. to Second Amended Bill, page 22, Transcript), when it could at any time during the controversy, have had the suit dismissed, *as to it*, under the rule laid down in *Lightner vs. Kimball*, 1 Lowell, 211.

It certainly seems strange, that the Southern Pacific Company, as a joint defendant with Whittier, Fuller & Co., should file an answer to the second amended bill of complaint, on the 6th day of January, 1890, and thus bring suit to issue, as to it, when its co-defendant demurred to the bill on the same day its answer was filed, and Whittier, Fuller & Co. did not file its answer until the 3d day of May, 1890, almost three months after the case was at issue as to the Southern Pacific Company.

It certainly seems strange, that the Southern Pacific Company persisted in remaining a defend-

ant, although it never appeared, after filing its answer to the second amended complaint; took no testimony, nor any part in taking testimony, or in any way aiding in the defense of the case.

The Issue before the Lower Court.

In the lower Court, the issues presented were: First, that the claim of the patent covered a mere aggregation; second, that it involved no invention or exercise of the inventive faculty, and thirdly, that under the proofs, no infringement was shown; in other words, that respondent Whittier, Fuller & Co.'s oil car, was not an infringement on complainant's patent, even if complainant's patent was good and valid.

The Judge of the Circuit Court sustained the first proposition, viz: That the claim of complainant's patent is for a mere aggregation, and therefore under the numerous decisions cited was void. In thus disposing of the patent and suit, it was not necessary for the Court to pass upon the other issues, and it did not.

Complainant's Patent.

The patent sued on, Complainant's Exhibit A, was issued June 17th, 1879, and it is set out on pages 127-128 and 129 of the transcript.

In the statement of the invention at the commencement of the specification, the inventor says:

“My invention relates to cars, and especially to *that class of cars*, designed for transporting merchandise and oil or other liquid.”

This is an admission that there was “a class of cars designed for transporting oil and other liquids,” *before the date of the alleged invention*, because the specification says, that it is to that class that the invention relates.

The specification then says, that the invention “consists in the parts and combination of parts hereinafter described.”

Then after describing such parts and combination of parts, the inventor says: “I am aware that the several features embodied in my improvement are not independently new, *and I restrict the invention to the specific combination of parts set forth in the claim.*”

This admission and restriction form a part of the patent, and we take it, that, in the face of such admission and restriction, the Court cannot give the claim any broader significance than the inventor intended to secure, and the Patent Office intended to grant.

The file wrapper and contents (not in the Tran-

script), which contains the various actions of the Patent Office on the patentee's application, shows that the patentee *was forced* into making this admission and restriction by the action of the Patent Office, and that he was driven by the references. to accept the patent as it was issued. His original claims were rejected on references that showed every feature of his car to be old, consequently the patentee was forced to make the admission and restriction, *in order to get a patent at all.*

“The disclaimer at the close of a specification
 “estops the patentee from setting up any privilege to the part disclaimed, and the summary is
 “equally binding on him as a limitation to the
 “thing patented.”

Whitney vs. Emmett, Bald., 303.

Consequently, the claim can only be construed to cover the elements named in the claim, combined and arranged as described in the specification, and indicated or illustrated in the drawings.

Aggregation.

Aggregation in the patent sense, is the gathering together into one machine, of two or more old devices, and there allowing each to perform the same duty it would perform *by itself*, or in any

other connection, *without bringing into action a new force or effect caused by the union.*

“Aggregation is not invention.”

Walker on Patents, page 24.

Applying these two propositions to the patent in question, we find that the specifications says *affirmatively* that each of the features embodied in the claim *is old*.

The claim can be divided into two main elements, first: a car divided into two or more compartments; and second, an oil tank of a peculiar construction. The description shows that the oil tank is merely placed inside of each of the end compartments of the car.

The tank is simply carried in this compartment, just as any other freight would be carried, if the other freight was substituted for the tanks, and in this sense the tanks may be called simply freight.

When the tank is filled with oil, *it is still freight.* It matters not whether it is empty or filled with oil, water or other liquid, it is carried in the car *simply as freight.* Whether the car moves or stands still, makes no difference with the function that the tank performs, and *vice versa*, the car moves just the same, whether the tanks are filled or empty. How, then, can there be any *joint action or co-action* between the car and the tanks?

“All the parts or devices of the combination claimed, must *co-operate* to produce a given result in order to form a legitimate combination, and if one part does not *co-operate* with the others, the patent is void for want of unity and *co-operation* of its several parts.”

Swift vs. Whisen, 3 Fish., 343.

Hoffman vs. Young, 18 O. G., 794.

Stephenson vs. Brooklyn C. T. R. R. Co.,
19 Blatch., 473.

“Co-operation does not mean acting merely together or simultaneously, but unitedly to a common end, a unitary result; each and every part must have its sub-function to perform, and each must have a certain relation to and dependence upon the other.”

Hoffman vs. Young, 18 O. G., 794.

“A combination, to be patentable, must produce a different force or effect or result in the combined forces or processes from that given by their separate parts. There must be a new result produced by their union; if not, it is only an aggregation of separate elements.”

Reckindorfer vs. Faber, 92 U. S., 347.

This is the doctrine as settled by the courts, and applying the rule, how can there be any *legitimate*

combination between a car and the freight (oil tank) which it carries? We care not how the oil tank is constructed, it cannot co-act with a railway car, in a patentable sense.

The construction of the tank *belongs to the tank alone*, and not to the car, and *vice versa*. If anything in the construction of the tank was new and patentable, it should be patented *as an improvement in oil tanks*, or if anything in the construction of the car was new and patentable, it should be patented *as an improvement in railway cars*; but the patent says that *none* of the elements are new. If then the construction of the oil tanks is old, and the construction of the car is old, the claim would resolve itself down to this: A railway car combined with oil tanks, and in this relation we can easily see that there would be no patentable combination, but a mere aggregation. It would be just the same as patenting the combination of a four-room house with a bedroom set.

The courts have held, over and over again, that such a bringing together of old devices is mere aggregation, and not invention, and have declared all such patents that have come before them to be void.

Alcott vs. Young, 16 Blatch., 134.

Hailes vs. Van Wormer, 20 Wall., 368.

Sarven vs. Hall, 9 Blatch., 524.

Hoffman vs. Young, 2 Fed. Rep., 74.

Reckendorfer vs. Faber, 92 U. S., 357.

Stutz vs. Armstrong, 20 Fed. Rep., 843.

Pickering vs. McCullough, 104 U. S., 310.

Bussey vs. Excelsior Mfg. Co., 110 U. S.,
131.

Roth vs. Royer, 49 O. G., 1987.

Hendy vs. Miners Iron Works, 127 U. S.,
370.

Beecher Mfg. Co. vs. Atwater Mfg. Co., 114
U. S., 523.

And many others.

The doctrine of aggregation is based on sound principles, and its application was found to be a necessity, in order to protect the public against a species of patents that create monopolies *in the odious sense*.

The authorities hold, and the bench to-day concedes, that a patent for a *new invention* is in no sense a monopoly.

Patents are only intended to be issued for *new inventions*. If the invention is new it did not exist before, and the public had no vested right to it, or its use. Hence the law rewards the inventor or discoverer, by granting to him, his heirs and assigns, the benefit of *what he actually invents*, for a limited

period, after which it reverts to the public. This is the way Congress has provided for "promoting the progress of science and the useful arts."

If the thing patented is old, or is not a newly-discovered thing, or does not involve invention, the patent takes from the public what belonged to it before the patent was issued, and gives the benefit of it to the patentee. It then becomes an odious monopoly, because it prevents the public from enjoying what by right it is entitled to enjoy. How such a grant could "promote the progress of science and the useful arts," it is difficult to see.

The public is one party to the grant of a patent, and it surely will not consent to give up any of its vested rights without any equivalent in return, and it is the duty of the courts, to guard these rights and see that no patent encroaches upon them.

What amounts to invention has been discussed and dwelt upon in the world of invention until its limits are thoroughly defined. The courts have decided over and over again, that a thing, to be patentable, must involve invention. The amount of invention is immaterial, but the inventive faculty must be exercised some way.

Common sense and mechanical skill or judgment can never amount to invention. If sugar and salt

have been granulated, and made in the form of a powder, so that they will dissolve readily in water, it only requires common sense or judgment to reduce glue to a powdered or granular condition to make it dissolve more readily in water. *Glue Co. vs. Upton*, 97 U. S., 3.

No invention is involved in the idea, and no valid patent can be issued therefor, because a patent cannot legally prevent anyone from using his common sense or exercising his ordinary judgment.

The courts have decided that aggregation is not invention. The huddling together of several old things is aggregation, if each thing performs only the same function that it performed before, and nothing more. The combination may be new, but that will not make it patentable. Suppose I should patent an improved legal brief, in which one-half is printed with printed type, and the other half with a typewriter, that would be a decided novelty, new in every sense, yet it would not be patentable, because it would not involve invention, but would simply be an aggregation.

In the field of mechanics elbow room is necessary. The mechanic must be given latitude to exercise his skill and judgment in bringing together and combining well known devices. A

man of good judgment, devoid of the least particle of inventive genius, can pick out a number of the best well known devices, in most any branch of mechanics and art, and combine them together so as to produce a superior machine or structure, and if the Government will give him a patent, for it he can control the market with this superior machine, yet he has simply used other peoples' inventions, and has himself only exercised good business judgment.

Bearing these propositions in mind, let us take the claim of the patent sued on and analyze it.

Claim. "A car subdivided into two or more
 " compartments, each end compartment containing
 " an oil tank, said tank constructed with an in-
 " clined or self-draining bottom, and resting upon a
 " floor formed in counterpart thereto, said tank
 " also having a tapering or inclined top, with a fill-
 " ing opening placed at or near its highest point,
 " and in line with a filling opening in the car top,
 " and there being a removable partition separating
 " said tank from the next adjacent compartment,
 " all combined substantially as set forth."

There are eight elements in this claim and I will consider them separately.

1. "A car subdivided into two or more compartments."

Every passenger car has two or more compartments; caboose cars and cattle cars have long been made with several compartments.

2. "Each end compartment containing an oil tank."

The object of an oil tank is to contain oil. When filled with oil and placed in a car it is simply freight. It is immaterial whether it is placed in a large compartment or a small one, its duty, office or function is not changed or affected thereby. There is no more joint action between the oil tank and the car, or between it and the compartment it is contained in, than there would be between the car and a bale of hay, or a trunk placed in the compartment or car. It is simply a package of freight. If the oil tank assisted the car in moving, or acted in any way on the functions of the car, it would be a different proposition, but it does not.

3. "Said tank constructed with an inclined or self-draining bottom."

This feature relates to the tank alone, and no connection or relation can be traced between it and the car, or the compartments of the car. If the feature was new, the inventor might claim it as an *improvement in oil tanks*, but it is not new and it has nothing to do with the car.

4. "And resting upon a floor formed in counterpart thereto."

Every tank that ever rested upon a floor rested in the same way. This feature has no relation to the function performed by either the track or car. It neither assisted in transporting the tank, nor in containing the oil to be transported, or in performing any of the functions of the car. It is simply a common sense method of supporting a tank having an inclined bottom. If the floor was not constructed in this way, blocks would have to be used, to support the tanks in position, and every mechanic knows that that would be a foolish way of supporting it.

5. "Said tank also having a tapering or inclined top."

This element simply relates to the tank, and has no relation to, or connection with the car, or the compartment of the car. As far as the car is concerned the top of the tank might be flat, rounded or conical.

6. "With a filling opening placed at or near its highest point."

As far as the car is concerned this filling opening could be anywhere, or arranged in any way, and for that matter, the function of the car would

be just the same, and in no way altered or affected, if the tank was filled outside the car, and then carried and deposited inside of it.

7. "And in line with the filling opening in the car top."

The same thing may be said of this element as of the 6th element.

8. "And there being a removable partition separating said tank from the next adjacent compartment."

What earthly connection has the partition with the functions of the oil tank, or the car? Take the partition down and throw it away, and the functions of neither would be affected in the slightest degree.

These are all the elements of the claim. The patentee might have gone on and added other parts of the car to the claim. For instance, he might have included a particular kind of car-truck, and special wheels, and a particular kind of car-coupling, etc., etc., with as much right as he had to include the features mentioned in his claim; and with a great deal more color of right, he might have included a special kind of roof, for if he had a right to include the floor and partition, he certainly had as much right to include the roof.

The learned Judge who decided this case in the Court below, placed his decision in line with the decisions of the highest courts in the land, regarding this class of patents, and I have no fear that this Court will view this case in any different light.

No Invention.

But, if the Court should find that the claim of complainant's patent does not cover an aggregation, I then fall back one step, *and say that it does not involve invention.* A machine may be a combination of old devices, which, *by their peculiar arrangement and adaptation, produce a new result.* The relation in which the parts are placed, may bring into action *new forces*, and thus constitute *an improved machine.* In such a case, although all the separate parts are old, the whole would constitute a legitimate combination. The question would still remain, does it require invention to make the new arrangement?

In *Hicks vs. Kelsey*, 18 Wall., 670, the Court said in effect, the patentee knowing, as all men are supposed to know, the common properties of an iron bar, concluded that such properties would make it more useful in a wagon-reach, than the wooden bar previously used for that purpose. He therefore substituted the iron for the wood. The mental act performed was a mere inference.

Knowing the office of the wagon-reach, and the properties of an iron bar, the patentee inferred that the wagon-reach would be stronger if made of iron, as any one might have inferred, at least any one skilled in the art of wagon making. Therefore the Supreme Court held that it was no invention to substitute iron for wood. In an earlier case in the same Court, *Hotchkiss vs. Greenwood*, 11 How., 248, the patent was for a porcelain door knob, composed of a knob proper, and a shank inserted therein, whereby the knob was fixed to the door. The knob itself was old, and the shank was old. All that the patentee had done was to bring this porcelain knob and this particular shank together. By so doing he made a door knob *better than any in use before it*, but the knob having been useful with other shanks, and the shanks with other knobs, it was a legitimate inference that they would be useful together, and it was held that no invention was required to adapt them to each other.

Now, apply the same rule to the case we are discussing. The patentee admits that all the elements are old. All he has done then, is to arrange them together in their proper relation in a car. Any man of good judgment, in constructing a car for hauling oil, would be able to put them together in

the manner shown, without in any way exercising the faculty of invention.

The case of *Densmore vs. Schofield*, reported in 102 U. S., at page 375, was a patent for an oil car. The 2d claim in that patent was as follows:

“2. The two tanks B B (or their equivalent) “ when set directly (or nearly so) over the car “ trucks, and when constructed and operating in “ combination with an ordinary railway car, sub- “ stantially as and for the purposes set forth.”

This entire patent was declared void, the Court saying: “ It strikes us that the entirety, and all of “ the particulars of the summary, and the claims, “ are frivolous and nothing more.”

Brown, the patentee of the patent sued on, simply took what the Supreme Court in that case declared to be *frivolous in all its entirety*, and by simply changing some of its features, in a way that he admits was old, at the time, secures a patent for it. If Densmore's patent was frivolous in all its entirety, complainant's patent is open to the same charge. I might cite an endless list of authorities, wherein just such claims have been declared to be void; but I apprehend that what I have already said under this head, is sufficient to show that the alleged invention of complainant is no more than

the exhibition of good business judgment, in adapting parts together; and I even question the judgment that adapted the parts to each other, because it is evident to the Court, from a mere inspection of complainant's car, that it is very badly arranged: In the first place it was not good business judgment to place the tank compartments, and the tanks, directly over the car trucks. In this location the tanks are subjected to the pounding of the wheels on the tracks, and are thereby rendered more liable to leak than if they were located over the middle of the car. Again, the floor of the tank compartments slope, or incline towards the dry compartment, so that in case one of the tanks should spring a leak, the dry compartment would be flooded. It is true that the patentee says, in his specification, that the slope or incline of the floor of the end compartment "is gradually elevated towards each " end of the car, thus affording a reliable drainage, " which would secure the contents of the central " compartments against damage, should either tank " leak," but such statement is evidently an error. Exactly the reverse would occur, and it needs only a casual examination to prove that fact. We think, therefore, that the Court will conclude with us, that a car constructed like complainant's car, is not the result of even good business judgment.

The Economy of the Thing.

The only new result or new effect, that counsel for complainant have claimed for their car, is, that it enables the complainant to deliver oil on this coast. at a saving of \$95 per car load, when compared with the old style tank car.

They made no attempt to compare the economy of complainant's car, with that of the Brooks or Keeler, or any of the various prior cars shown by the patent, Exhibits 2 to 8, Transcript.

The only quality of complainant's car that enables it to save this \$95 per trip, is its quality of having a dry compartment separate from the tank compartment, so that oil could be hauled in one direction, and dry freight in the opposite direction; but this quality is contained in each of the prior patented cars, so that it was not a new quality devised or brought into effect for the first time, by the patentee Brown.

Whittier, Fuller & Co. could have saved this \$95 per trip, by obtaining one of these prior patented cars, and using such cars instead of devising a new one, so that this threadbare and much harped upon matter of saving \$95 per trip is not due to Brown's patent, nor to his invention. In fact, the patent itself does not claim any such construction or object. The claim is made by counsel, simply

because it was the only advantage they could hatch up, for complainant's car, and without some showing of merit, they had no case.

But to follow this matter further, and before doing so, I will state that counsel's whole argument and claim of infringement, in the Court below hinged upon this saving of \$95 per car load; it was the one theme that counsel dwelt upon, to prove the great superiority of complainant's car, and to give a foundation for the validity of complainant's patent. No other advantage or foundation for patentability was claimed or mentioned. Now let us see what value there is in such a claim. The rates for hauling these cars are made by the railroad companies that haul them. It appears that such companies consent to haul these combination cars, and to use the freight compartment for hauling freight in one direction, for its own purpose and advantage, and by this means *pay itself* for hauling the cars back and forth, instead of making the owner of the car pay for hauling them. *But suppose that the railroad companies should change these rules: suppose they would say, you must pay for hauling your cars in both directions, in that case what would become of counsel's claim of economy? In that case what would be the advantage of complainant's car over the old style tank car? Certainly our Govern-*

ment does not issue patents, *the validity of which depends upon the rules of a railroad company*, and this would be the result if the validity of complainant's patent, depended alone on this saving of \$95 per trip.

The law requires that a combination, to be new and patentable, must produce a new result—must contain a new function or property. The only new function or property claimed for complainant's car, is that it saves \$95.00 per trip for its owner. *This saving depends upon a rule of a railway company; hence the validity of the patent depends upon a rule of a railroad company.* This is correct logical reasoning, and shows upon what a false and fictitious foundation the validity of complainant's patent rests.

But I go further, and in this respect I differ from the position taken by his Honor, Judge Sawyer, when he refused to sustain the demurrer to the second amended complaint. I hold that no machine or device is patentable, merely because it produces economy in its operation. Things are done every day that result in economy. A very slight common sense change or alteration might change a poor machine into a better one, yet, unless it involved the inventive faculty, it would not amount to invention or be patentable. If mere

cheapening the operations of life affairs, is patentable (and that is what is claimed for this patent), the Central Pacific Railroad Company might secure a patent on a transcontinental railway, because it made it possible to carry freight from Omaha to San Francisco much cheaper than it could be brought by ox team or overland express, thus accomplishing for general traffic, exactly what the patentee here claims to have done for the oil trade.

It may be conceded, that where the invention makes *the thing invented cheaper of production*, cheapness is an element to be considered in determining the patentability, *but the cheapness must relate to the thing invented, and not to the work it does after it is made.* For instance, if Brown, the alleged patentee, had made an invention whereby he could manufacture *the car* cheaper than *other cars*, the element of cheapness is considered, and is material to be considered, in sustaining the patent, for there the cheapness relates directly to the thing invented, but there is no claim of that kind in this case. It is not claimed that an oil car, made under Brown's patent, would be any cheaper in construction than any other oil car. The only claim is that a car, *after it is constructed*, after the alleged patentable arrangement is made,

can, *after it is completed*, do cheaper work than certain other kinds of cars. If there were no other cars in existence before Brown's alleged invention, that would carry oil as cheaply as his, there might be some slight foundation for the claim of cheapness set up by complainant, *but there were*. Any of the cars shown and described in the prior patents, would carry oil just as cheaply as complainant's car, under the same circumstances. They would carry merchandise in one direction and oil in the other, and, in effect, would do just what complainant's car does. In that state of facts, it certainly is not sufficient to claim that the element of cheapness will save complainant's patent, if that is the only result complainant relies on, *because it is not a new result*.

Further, it does not appear that the result of complainant's alleged invention is "the cheapening of transportation of oils." The testimony shows that it costs just as much to transport the oils in complainant's car, as it does to transport it in other, or ordinary, tank cars. The only showing is, that the complainant is able to have the railroad company carry the car back for nothing, *after it has transported the oil*. If the complainant should haul water, or molasses, or any other freight in its tank compartments, it would be the same,

and, for that matter, the same would happen if the car run entirely empty in one direction, so that it does not tend to cheapen the transportation of oil. The cost of transporting the oil is just the same as in the tank cars, only another means is provided for paying for the transportation. But that same means existed before. Judge Sawyer did not know this when he decided the demurrer, because the prior patented cars were not before him, and he had no knowledge that any car existed before complainant's alleged invention, that would carry oil in one direction and dry merchandise in the opposite direction. The Court now has these patents before it, and it now views the patent from a different standpoint from that in which it was viewed by Judge Sawyer, when he rendered that decision. If Judge Sawyer had been informed, when he rendered that decision, that there existed former cars, in which oil could be transported in one direction and dry merchandise in the opposite direction, is it reasonable to suppose that he would have based his opinion overruling the demurrer on the cheapening of the transportation of oils? Apparently not. He would have readily seen that these prior cars would transport oil just as cheaply as complainant's car, and he would have found no new result arising out of the alleged patented car. In that

case he would, without any doubt, have sustained the demurrer.

Infringement.

But outside of any of the defenses hereinbefore urged, I contend that respondent's car is no infringement upon complainant's patent. I insist that the testimony shows beyond the shadow of a doubt, that the defendant's cars do not contain the combination or devices called for in the claim of complainant's patent.

Remembering first, that the patentee emphatically restricted his invention to the specific combination of parts set forth in the claim, I will consider these parts, and compare them with the parts of defendant's car.

The first element of the claim in complainant's patent is, "a car subdivided into two or more compartments."

Respondent's car unquestionably contains this element; so do all of the cars represented in the prior patents. In fact, so far as this element, standing separate and alone is concerned, it is shown in every caboose car, that was ever made, so that defendants had a perfect right to divide their car into two or more compartments.

“ Each compartment containing an oil tank.” In Whittier, Fuller & Co.’s car, each end compartment *does not* contain an oil tank. On the other hand, their car reverses the order of things, and the oil tank is in the middle of the car. By this arrangement and disposition of the oil tank, Whittier, Fuller & Co. secure several important advantages over complainant’s car; first, the oil tank is in the middle of the car, where it gets the advantage of the spring, or yield of the car frame and timbers, thus relieving it from the shock and jar it is subjected to, when located directly over the trucks; it is consequently less liable to leak; secondly, it is in a better location to be filled and discharged; and thirdly, the floor of the compartment can be pitched towards the middle of the car in each direction, thus giving a decided advantage in draining off leakage, and preventing the leakage from flooding the dry compartments.

Again, complainant’s patent shows, describes and contemplates the employment of two oil tanks; whereas, defendant, Whittier, Fuller & Co., use only one. Counsel for complainant say, that this is immaterial; that Whittier, Fuller & Co. have simply forced complainant’s two tanks to the middle of the car, and made them into one. They do not point to anything in complainant’s specification, or drawing, that says or hints that their two tanks

could be crowded to the middle of the car, and made into one tank, and inclosed in one compartment instead of two; on the contrary, the inventor said in his specification: "I restrict the invention "to the specific combination of parts set forth in "the claim." This estops complainant from claiming that Whittier, Fuller & Co.'s combination of parts, is the same as that stated in the claim of the patent.

The next element of complainant's claim is "said "tank constructed with an inclined or self-drain-
"ing bottom."

Whittier, Fuller & Co.'s tank is not constructed with an inclined or self-draining bottom. Its bottom is flat, but the floor or the compartment upon which it rests, is made inclined and self-draining. (See complainant's Exhibit B, page 130, Transcript; also, see prior patent of Keeler, respondent's Exhibit 6, page 155, Transcript).

The next element is, "and resting upon a floor formed in counterpart thereto."

An examination of complainant's Exhibit B will readily show, that the tank in Whittier, Fuller & Co.'s car does not rest upon a floor formed in counterpart thereto. This model was made by complainant, and it is proved to be a correct model of

Whittier, Fuller & Co.'s car, except that the maker, Louis Peterson, a model maker, admitted that the top of the tank should have been made perfectly flat, whereas, it is slightly higher at one end than at the other. (See Peterson's answers to X.-Q. 3, 4 and 5, page 70, Transcript). Otherwise the model is correct, and it shows plainly that the bottom of the tank is flat, and the floor of the compartment inclined, so that the bottom of the tank does not rest upon a floor formed in counterpart thereto.

The next element is, "said tank also having a tapering or inclined top." Certainly and truly the tank in Whittier & Fuller's cars has no inclined top; complainant's own witnesses make that proposition plain.

Ueffinger was complainant's witness. He was the draughtsman and expert that complainant's counsel took to Fourth and Townsend streets to examine and make a proper drawing of Whittier, Fuller & Co.'s cars. The drawing, complainant's Exhibit "B," was made by him directly from Whittier, Fuller & Co.'s cars. He testified as follows, on page 65, Transcript.

"X.-Q. 69. The top of the tank, as shown in "the drawing, Exhibit B, was flat, was it not?"

"A. Yes, it was flat."

No evidence contradicting this fact was produced.

How then can counsel claim that the top of Whittier, Fuller & Co.'s tank is tapering or inclined?

At the hearing before the Court below, counsel argued that the dome of Whittier, Fuller & Co.'s car was inclined, and that consequently, that was the equivalent of making the entire top of the tank inclined. Apparently no argument is necessary to combat such a proposition. How any sane man can contend that rounding the end of the dome, which is about eighteen inches in diameter, is the equivalent of making the entire top of the tank—which is 8x12 feet in size—tapering or inclined, I cannot understand. The dome in Whittier, Fuller & Co.'s tank is simply the filling opening. Its top is slightly rounded for convenience in manufacturing it. This rounded top of the dome performs no office in connection with the tank, but is simply an incident of manufacture. Complainant is bound by its own testimony, and that establishes conclusively that the top of Whittier, Fuller & Co.'s tank is flat.

The next element is “with a filling opening placed at or near its highest point, and in line with a filling opening in the car top.”

Whittier, Fuller & Co.'s tank has a filling opening at its highest point; so has Brooks & Keeler's, and every other tank ever used in a car or any-

where else, for that matter, but not in line "with a filling opening in the car top" in the sense used in the patent. By examining the drawing and specification of complainant's patent, we find that the tanks in the end compartments are small enough *to be removed from the compartments*; that is, when the partition, which separates the tank compartment from the middle compartment, is removed, the tanks can be moved into the middle compartment, and taken out through the door of the middle compartment, thus removing the tanks entirely from the car. Consequently, the tanks are much smaller than the compartments, *and their tops are some distance below the top of the car.*

Understanding this, it is easy to comprehend what was meant in the claim, by having a filling opening in the oil tank, *in line* with a filling opening in the car top. In the Whittier, Fuller & Co. car, the dome of the oil tank passes out entirely through the opening in the car top, so that the oil enters the dome before it passes below the car top, and when I say car top, I do not refer to the square box that projects above the car top, but to the roof of the car.

Therefore I say, that in the sense these words are used in complainant's patent, the Whittier, Fuller & Co. tank *has no filling opening in line with an opening in the car top.*

The last element of complainant's claim is: "and
 " there being a removable partition separating said
 " tank from the next adjacent compartment."

This element has been the subject of much discussion in this case. While the claim says "*removable* partition," the specification says "these
 " partitions I make readily *adjustable* in order
 " that by their removal," etc.

It is therefore obvious that the word "removable" in the claim means "readily adjustable." Removable, in its broad sense, applies to everything but the earth, sun, moon and planets, and for all we know, there is some Power that can even remove them; certainly the word "removable" was not used in that sense in the claim.

In *Page vs. Ferry*, 1 Fish., 298, the Court said:
 " The intention of the inventor, so as to effect the
 " object designed, is to govern the construction of
 " the language he employs."

And in *Parker vs. Sears*, 1 Fish., 93, the Court said:

" There may be a liberality of construction very
 " injurious to the public, especially if it permits a
 " patentee to couch his specification in such ambiguous terms that its claims may be contracted
 " or expanded to suit the exigency."

If such is the rule for construing a specification, how much more strict should the courts be to confine the words of the claim to those found in the specification?

The device shown in the drawings of complainant's patent for securing the partition in place, consists of rods passing through holes in the side timbers, with nuts for confining them in place. By simply unscrewing the nuts, the bolts or rods can be withdrawn, and the partition removed.

If we then construe the word "removable" which is found in the claim, with reference to the description found in the specification and drawings, we can give it no greater effect than *a partition which can be readily taken down without marring or destroying any part of the car.*

It is admitted that the partition in Whittier, Fuller & Co.'s car, is composed of matched, or tongued and grooved boards, nailed firmly to four upright timbers, just like a floor is laid and nailed. In order to take it down, a hammer and cold chisel is required. This I claim is not a removable partition, in the sense the word "removable" is used in the patent. In the broad and general sense it is removable, if force sufficient is applied, and in the same sense the Appraiser's Building in which this Court is held is removable.

The fact is, Whittier, Fuller & Co.'s construction does not require that the partition should be readily removable; *in fact, it is never removed; there is no necessity to remove it.* Complainant removes the partition in the patented car in order to enable them to take the tanks out of the car.

Whittier, Fuller & Co. could not take the tank out of their car, even if the partition was removed. The dome of their tank extends up through the roof of the car, so that the roof or bottom of the car, one or the other, would have to be broken away or destroyed in order to remove the tank from the car. What use, therefore, would it be to them to have a removable partition?

It is certainly astonishing in view of these facts, that complainant's counsel should persist in insisting that Whittier, Fuller & Co.'s cars have removable partitions. They not only insist, but they have resorted to a trick model to make out, that the partitions in the Whittier, Fuller & Co. cars are removable. This model is ingeniously devised and arranged to mislead the Court. We say that no such construction exists, or ever did exist, in Whittier, Fuller & Co.'s cars. The first time it was ever illustrated to this counsel, that the partition in that model could be taken out in one piece, was at the hearing in the Court below.

Ueffinger, complainant's own witness and expert, testified as follows, page 63, Transcript:

"X * Q. 39. Before the timbers could be removed, the side boards, or boards of the partition, would have to be knocked off?

"A. Yes, sir."

Again, on page 75, the same witness testified:

"Q. 6. How were the end uprights of the partition connected with the car body or frame?

"A. To the best of my knowledge, they were a part of the frame of the car.

"Q. 7. When you say 'a part of the frame of the car,' what do you mean, the permanent part or temporary loose part?

"A. Well, a permanent part.

"Q. 8. Then you found that each one of the boards of the partition was nailed to each one of these end uprights, did you?

"A. Yes, sir."

Again the testimony shows (*Ueffinger's* testimony, Q. 8 to Q. 14, inclusive, page 61, Transcript) that the witness and complainant's counsel only took off one board from the top of the partition. How, then, is it possible that they could determine how the partition was constructed, *except by guessing at it?* We therefore attack the

correctness of this exhibit, and denounce it as a trick model.

In view of all these facts and circumstances, we say that Whittier, Fuller & Co's cars have no *removable* partition. It would be of no use if they had one.

These comprise all the elements of the claim stated in the patent. But the claim ends "all combined substantially as set forth," so that to infringe the claim, the Whittier, Fuller & Co's cars must not only contain all the elements of the claim, but they must all be combined *substantially as described* in the specification, and illustrated in the drawing. To give the patent a broader construction would make the cars covered by the prior patents in evidence, infringe upon complainant's patent, which would involve a legal absurdity.

Having thus compared Whittier, Fuller & Co's construction with the claim of complainant's patent, we formulate this difference:

Whittier, Fuller & Co's car is "a car subdivided into two or more compartments," but it does not have "each end compartment containing an oil tank." Whittier, Fuller & Co's tank is not "constructed with an inclined or self-draining bottom," and does not "rest upon a floor formed in counter-

part thereto." Whittier, Fuller & Co's tank has not "a tapering or inclined top." It has "a filling opening placed at or near its highest point," but such opening is not "in line with a filling opening in the car top," and there is no "removable partition separating said tank from the next adjacent compartment.

Let us now formulate a claim on Whittier, Fuller & Co's car, and see how it compares with the claim in complainant's patent.

Whittier, Fuller & Co.'s car is a car subdivided into three compartments; the middle compartment being twice the size of each end compartment, and containing a single tank; said tank having a flat top and bottom, but resting upon a floor that inclines in both directions from a middle line across the transverse middle of the car, and having a dome extending upwards from its top through and above the car roof; the upper end of said dome being protected by a curbing above the roof; said dome being open at its top, and serving as a filling passage to the tank, and a fixed permanent partition separating said tank compartment at each end of the tank from the end compartments.

Compare these two claims and we see at once that the two cars are radically different, although intended to perform the same duty.

The Law of the Case.

The claim in complainant's patent is a combination claim.

“To constitute an infringement of a combination, the entire combination must be used, because the patentee claims not the various parts, but the whole combination together.”

Case vs. Brown, 2 Wall., 320.

Barrett vs. Hall, 1 Mason, 447.

Smith vs. Downing, 1 Fish., 64.

Carr vs. Rice, 1 Fish., 198.

Bell vs. Daniels, 1 Fish., 372.

Latta vs. Shark, 1 Fish., 465.

Singer vs. Wahnsley, 1 Fish., 558.

Lee vs. Blandy, 2 Fish., 89.

Bean vs. Smallwood, 2 Story, 408.

Vunce vs. Campbell, 1 Fish., 483.

Silsby vs. Foote, 1 Blatch., 445.

Howe vs. Abbott, 2 Story, 190.

McCormick vs. Talcott, 20 How., 402.

Ecaus vs. Eaton, 1 Pet. C. C., 322.

Brooks vs. Bicknell, 4 McLean, 370.

Foss vs. Herbert, 2 Fish., 31.

Pitts vs. Wemple, 6 McLean, 558.

Hale vs. Stimpson, 2 Fish., 565.

Manly vs. Sizer, 1 Fish., 17.

Dodge vs. Carst, 2 Fish., 116.

Washing Machine Co. vs. Tool Co., 20 Wall.,
342.

Nicholson Co. vs. Hatch, 4 Sawyer, 692.

Blanchard vs. Putnam, 8 Wall., 420.

And numerous others.

“If a patentee combines parts that are old, another may combine the same parts, so long as he does not use the same combination.”

Pattee vs. Moline Plow Co., 9 Fed. Rep.,
821.

Washburn & M. Manuf'g. Co. vs. Griesche,
16 Fed. Rep., 669.

“If a change in the mode of arranging the elements of a combination produces a different and better result, there is no infringement.”

Habeman vs. Whitman, 5 Ban. and Ard.,
530.

“If the elements of the combination are not connected and arranged in the same manner, there is no infringement.”

Singer vs. Walmsley, 1 Fish., 558.

“If a party uses all the parts of a combination
“ but one, and for that substitutes another mechan-
“ cal structure, substantially different in its con-
“ struction and operation, he is not guilty of an in-

“fringement. It is not the same combination if it
“substantially differs from it in any of its parts.”

Eames vs. Godfrey, 1 Wall., 78.

Merriam vs. Drake, 9 Blatch., 336.

Prouty vs. Ruggles, 16 Pet., 336.

Knox vs. Murtha, 9 Blatch., 205.

Stimpson vs. Balt. and Sus. R. R. Co., 10
How., 329.

Eddy vs. Dennis, 95 U. S., 560,

And others.

“If the state of the art is such, that the patent
“must be confined within narrow limits, an article
“will not be deemed to be an infringement unless
“it possesses all the characteristics of the thing
“patented.”

Scott vs. Evans, 11 Fed. Rep., 726.

“If the invention claimed be itself but an im-
“provement on a known machine, by a mere
“change of form or combination of parts, the
“patentee cannot treat another as an infringer,
“who has improved the original machine by the
“use of a different form, or combination perform-
“ing the same functions. The inventor of the
“first improvement cannot invoke the doctrine of
“equivalents, to suppress all other improvements
“which are not colorable invasions of the first.”

Burr vs. Duryee, 1 Wall., 431.

McCormick vs. Talcott, 20 How., 402.

Union Sugar Refinery vs. Mathiessen, 3
Cliff., 639.

Taylor vs. Garrison, 5 Fish., 116.

And others.

A combination claim cannot be broadened by construction.

Walker on Patents, Sec. 186.

This is the law to be applied to this case, as far as the question of infringement is concerned, and I respectfully submit that it makes a case too plain for argument, that Whittier Fuller & Co's cars do not infringe upon complainant's patent.

The Cylindrical Tank Car.

I have not referred specifically to this car of Whittier, Fuller & Co., because it seems too evident that the claim of infringement made against it is absurd. It has no partitions whatever. It has no floor formed in counterpart of the cylindrical tank that rests upon it. It is a short cylindrical tank supported on timbers in the middle compartment of a car. It has a dome extending through the roof, so that the tank cannot be removed from the compartment without destroying a part of the car. In fact, it possesses none of the features of the

patented car, except that it is a tank in a car that will carry oil.

I therefore most respectfully submit:

First. That the ruling of the lower Court was correct and there was no error, that complainant's letters patent are void, on the ground that the alleged invention is merely an aggregation, and not patentable.

Second. If said alleged invention is not merely an aggregation, the patent is void for want of invention, and

Third. That no infringement has been shown.
Respectfully submitted.

JOHN L. BOONE,
Solicitor and of Counsel for Respondent Whittier,
Fuller & Co.

APPENDIX.

Opinion of HAWLEY, J., on final hearing dismissing Bill, in U. S. Circuit Court:

HAWLEY, J. This is a bill in equity for the infringement of letters patent No. 216,506, granted to M. Campbell Brown, June 17, 1879, and assigned to complainant, for "improvement in oil-cars." The specification in the patent recites as follows:

"My invention relates to cars, and especially to that class of cars designed for transporting merchandise and oil or other liquids, and it consists in the parts and combination of parts hereinafter described and claimed, whereby oils or other liquids may be safely transported in the same car with miscellaneous merchandise * * * The object, as briefly above stated, of my device, is to produce an improved form of car for the transportation of oils and liquids in bulk, and which shall also be adapted for the transportation of ordinary merchandise on roads where a load of oil or liquid cannot be obtained on return trip, thus obviating the necessity of hauling empty tank-cars over long distances, as is now commonly done; and to this end the construction of the ordinary freight-car is modified as follows: The car space is divided into two or more compartments; but, for the purpose of the present specification, we will suppose it to be divided into three. The central compartment, as shown in the drawings, would embrace about two-thirds of the entire length of the car, and is designed and adapted for ordinary storage, and for this purpose may be constructed in any proper

manner. The two end compartments occupy each about one-sixth of the entire length of the car, are located in the ends thereof, over the trucks, and are designed and constructed to contain metallic tanks, * * * which tanks are adapted for safely containing and transporting oil or other liquid. * * * I am aware that the several features embodied in my improvement are not independently new, and I restrict the invention to the specific combination of parts set forth in the claim. What I claim is: A car subdivided into two or more compartments, each end compartment containing an oil-tank; said tank constructed with an inclined or self-draining bottom, and resting upon a floor, formed in counterpart thereto; said tank also having a tapering or inclined top, with a filling opening placed at or near its highest point, and in line with a filling opening in the car-top, and there being a removable partition, separating said tank from the next adjacent compartment, all combined as substantially set forth."

Is this invention a mere aggregation, or is it a patentable combination? What is the distinction between mere aggregation and a patentable combination? A combination of well-known separate elements, each of which, when combined, operates separately and in its old way, and in which no new result is produced which cannot be assigned to the independent action of one or the other of the separate elements, is an aggregation of parts merely, and is not patentable. But if to adapt the several elements to each other in order to effect

their co-operation in one organization demands the use of means without the range of ordinary mechanical skill, then the invention of such means to effect the mutual arrangement of the parts would be patentable. The parts need not act simultaneously, if they act unitedly to produce a common result. It is sufficient if all the devices co-operate with respect to the work to be done, and in furtherance thereof, although each device may perform its own particular function only.

In *Hailes vs. Van Wormer*, the Court said:

“ It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be the product of the combination, and not a mere aggregation of several results, each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. No one, by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations; or, even if a new and useful result is obtained, can prevent others

from using some of the devices, omitting others in the combination." 20 Wall., 368.

In *Reckendorfer vs. Faber*, the Court said:

"The combination, to be patentable, must produce a different force or effect or result in the combined forces or processes from that given by their separate parts. There must be a new result produced by their union. If not so, it is only an aggregation of separate elements." 92 U. S., 357.

In *Pickering vs. McCullough*, the Court said:

"In a patentable combination of old elements all the constituents must so enter into it as that each qualifies every other. * * * It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions." 104 U. S., 318.

Numerous other authorities might be cited, substantially to the same effect. The law is well settled, the principles clearly defined. The dividing line between mere aggregation and patentable combinations is well established. Every case must fall upon one side or the other. No case stands directly on the pivotal line. But the facts are often of such a character as to make it difficult to determine upon which side of the border line the case should be classed. This difficulty arises in the application of the facts to the principles of the law so frequently announced by the Supreme Court of the United States. If the question is considered

doubtful, the Court should overrule a demurrer to the bill, in order to have the question fully presented upon the final hearing. *Standard Oil Co. vs. Southern Pac. Co.*, 42 Fed. Rep., 295, opinion by Judge Sawyer. And in such a case the Court for like reasons would be justified in cases of great hardship to refuse an injunction, or dissolve a restraining order if one is temporarily issued. *Standard Oil Co. vs. Southern Pac. Co.*, decided by Judge Hoffman. But when the cases comes up on final hearing it is the duty of the Court to assume the responsibility of actually determining upon which side of the border line the case falls. To properly decide this question the Court should constantly bear in mind not only the principles of law applicable to such cases, but must keep in view the reasons for the rule upon which said principles were founded.

The several features embodied in complainant's improvement are admitted not to be independently new. The contention is that new and useful results are reached that were not hitherto attainable under the prior state of the art. The result claimed to be new is the cheaper transportation of oil in bulk over long hauls; that is, by the combined use of the patented car complainant is enabled to save the expense of \$95 hitherto paid for the expense of the return of an empty car. It is not claimed that the carrying of oil one way cooperates directly with the performance of carrying

dry merchandise the other way, but the point relied upon is that the two co-operate directly in the performance of carrying merchandise both ways, thereby producing a common result, viz: a reduction of the cost of transportation of oils by successive acts performed in different parts of the service of the car; this result being, as before stated, in saving the dead loss of hauling empty cars one way. If this contention is sound, then the patent must be maintained. Is it tenable? I am of opinion that it is not. The construction of this patent, as contended for by complainant, would, in my judgment, be extending the principle of patentability of inventions beyond the rules laid down by the Supreme Court of the United States in its recent decisions upon this subject. The patentee admits that the several features in his improvement "are not independently new." Upon the hearing prior patents were introduced, which embodied the general feature of carrying oils or liquid and dry freight at the same time, or "for liquid freight in one direction and dry freight in the other." Do the elements of the car and of the oil-tank combined so co-operate as to produce a new result by their joint union? Successive action of old parts, where they all relate to each other, and all work to a common end to perform a common result, if the result is new, are patentable, but in all cases it must be a result which is due to the successive action of these parts. In *Reckendorfer*

vs. *Faber, supra*, numerous illustrations are made. There the combination relating to the manufacture of combined pencils and erasers consisted only of the application of a piece of rubber to one end of the same piece of wood which makes a lead-pencil. The Court said:

“ It is as if a patent should be granted for an article * * * consisting of a stick, twelve inches long, on one end of which is an ordinary hammer, and on the other end is a screw-driver or a tack-drawer. * * * It is the case of a garden-rake, on the handle end of which should be placed a hoe, or on the other side of the same end of which should be placed a hoe. In all these cases there might be the advantage of carrying about one instrument instead of two, or of avoiding the liability to loss or misplacing of separate tools [and the Court might have added that the cost of manufacturing the articles would be much less, and that the combined articles could be sold cheaper than the separate articles could]. The instruments placed upon the same rod might be more convenient for use than when used separately. Each, however, performs its own duty, and nothing else. No effect is produced—no result follows—from the joint use of the two.”

Now, in the case of the lead-pencil and eraser, the hammer and screw-driver, and with the garden-rake and hoe, there was not only a convenience and cheapness in the manufacture of the articles, as combined, but in their use. Time would be saved in the work to be performed by having the

articles in the combined instrument; and, if the sole question of cheapness in the use was to govern, then the decision in the *Faber Case* should have been the other way. The patent should have been sustained. The new result to be accomplished, in order to take the case out of the rule of aggregation of separate elements as laid down by the Supreme Court, must be a result produced by the manufacture of the article or machine itself, its operation, union, and effect. Such illustrations are made in the case already cited, as, for instance, the frame in a saw-mill which advances the log regularly to meet the saw, and the saw which saws the log. The two co-operate and are simultaneous in their joint action of sawing through the whole log. Or in the sewing-machine, where one part advances the cloth and another part forms the stitches, the action being simultaneous in carrying on a continuous sewing. A stem-winding watch-key is another instance. The office of the stem is to hold the watch or hang the chain to the watch; the office of the key is to wind it. When the stem is made the key, the joint duty of holding the chain and winding the watch is performed by the same instrument. A double effect is produced, or a double duty performed, by the combined result. In these and numerous like cases the parts co-operate in producing the final effect; sometimes simultaneously, sometimes successively. The result

comes from the combined effect of the several parts, not simply from the separate action of each. In this case there is no joint operation or effect in the construction of the railway car and the oil-tank combined which is in any manner due from the simultaneous or successive action of the two as combined. It is a mere aggregation of old elements, producing no new result by the combination.

I deem it unnecessary to notice the contention of complainant's counsel relative to the peculiar construction of the car, further than to say that I have carefully examined this question, and, while it may be admitted, for the purpose of this decision, that the construction is such as to distinguish this case in some respects from *Densmore vs. Schofield*, 102 U. S., 375, which it is contended was for a claim for "the combination of a tank and a car, however united," it is not sufficient, in my opinion, to take this case out of the rule as stated in the other cases to which I have referred. I have not, in the consideration of this case, overlooked the fact so frequently announced that patents for inventions should always be liberally construed, and all doubts, if any exist, should be solved in favor of the patentee. I realize to the fullest extent the importance and necessity of upholding, sustaining, and encouraging the inventive skill and genius of the country. To quote the language of the Supreme Court of the United States:

“ Patentees, as a class, are public benefactors, and their rights should be protected. But the public has rights also. The rights of both should be upheld and enforced by an equally firm hand whenever they come under judicial consideration.”

The bill is dismissed.